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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,918	02/25/2004	Jean-Yves Coillard-Lavirotte	52022/TJD/M881	4980

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EXAMINER

KIM, JOHN

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/786,918	Applicant(s) COILLARD-LAVIROTTE ET AL.	
	Examiner John Kim	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 4 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 4 is objected to because of the following informalities: Claim 4 depends from a cancelled claim. For examining purposes, examiner will examine claim 4 to depend from claim 1. Appropriate correction is required.

Claim 11 is objected to because of the following informalities: Claim 11 depends from a cancelled claim. For examining purposes, examiner will examine claim 4 to depend from claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5, 9, 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Berentey et al. (US Pat 4,651,724 March 24, 1987).

In regards to claim 1-2 and 9, Berentey teaches of having a bone joining plate with a positioning stuc that is adjacent to the holes for bone screws. "The plates can be produced in different lengths and with different number of holes for handling the various fractures." (col 1 line 68 – col 2 line 1) The invention is "provided having an oblong plate curved according to the bone surface, where at least two holes are arranged along the longitudinal axis and at least three pointed claws bent from the material of the plate are arranged at one of its ends." (col 1 lines 42-46). Furthermore "holes may be circular

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or oval shaped, the latter one allows the excentric arrangement of screws, whereby compression may be applied to the fractured surfaces." (col 1 lines 50-53) In regards to claims 5 and 10-12, Berentey draws the plate to be a single-piece part. He also teaches the claws to be "perpendicular to the plate." (col 4 lines 61)

Furthermore, with regards to claim 5 and 10-12, it is noted that the invention of Berentey, et al. appears to be substantially identical to the device claimed, although produce by a different process, therefore the burden is upon the applicant to come forward with evidence establishing an unobvious difference between the two. In re Marosi, 218 USPQ 289 (Fed. Cir. 1983).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berentey et al. (US Pat 4,651,724 March 24, 1987) in view of Bailey (US Pat 5,607,430 March 4 1997). Berentey discloses a plate with anchor/stud used with a screw passing through a compression hole. Berentey does not disclose the material used for the plate. However, Bailey discloses the plate made from "a single solid piece of implantable metallic surgical alloy, such as stainless steel, titanium alloy..." (col 3 lines 60-63). It would have been obvious to one skill in the art at the time of the invention was made to manufacture the bone plate of Berentey in view of Bailey with metallic

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surgical alloy such as stainless steel and titanium alloy. Furthermore, Berentey discloses the claimed invention except for the material of the bone plate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the bone plate of either titanium or stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim and needs to overcome the objection noted above, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 3/6/06 have been fully considered but they are not persuasive.

Applicant's arguments in regards to claims 1-2, 5, 9, 10-12 are not found persuasive.

Applicant argues that Berentey fails to disclose a miniplat, which has an "anatomic profile in its frontal plane and in its sagittal plane... The claws located at one end of Berentey are not part of the frontal plane as they angle down from the frontal plane..." In regards to the claws, Berentey discloses that the claw can be either in plane with the plate or along the a tangent of the plate's plane (col 2:44-46), thus the claw can be a part of the frontal plane. In regards to the anatomical profile or a phalange, any one skilled in the art can invent the plate with more than one of numerous shapes or configurations for the purpose of attaching to the phalange. In re Dailey and Eilers, 149 USPQ 47 (1966).

Applicant's arguments in regards to claims 6 and 7 are not found persuasive. Applicant argues that since claims 6 and 7 depend directly from claim 1, which applicant argues does not overcome the deficiencies of the prior art. Since examiner has addressed the deficiencies and reaffirms the rejection of claim 1, dependent claims 6 and 7 are still rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK 


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER